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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,337

11/07/2005

Jan Schroers

L2:00555

1291

71897

7590

10/08/2008

KAUTH, POMEROY, PECK & BAILEY, LLP

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

10/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,337	<b>Applicant(s)</b> SCHROERS ET AL.	
	<b>Examiner</b> George P. Wyszomierski	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8,12-15,17,18,20,24-32,34,36,39,40,42,44,46 and 47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,6,8,12-15,17,18,20 and 24 is/are allowed.
- 6) ☒ Claim(s) 5,25,26,28,31,34,36,39,40,42,44,46 and 47 is/are rejected.
- 7) ☒ Claim(s) 27,29,30 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/25/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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1. The Amendment filed June 25, 2008 has been entered. Claims 1-3, 5, 6, 8, 12-15, 17, 18, 20, 24-32, 34, 36, 39, 40, 42, 44, 46 and 47 are pending in this application.

*Claim Interpretation*

2. It is noted that in instant claims 25-27, each of x, y and z can be zero. In claims 28-30, each of x and z can be zero.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The “wherein” clause in this claim appears to be superfluous. Three possible scenarios are recited for the ratio of Pd to Pt, based on the total content of Pd and Pt. Given that independent claim 1 requires the amount of platinum to be from about 39 to about 50 atomic %, and given further the amounts of other elements required in the alloy of claim 1, it does not appear possible for the ratio of Pd to Pt to be anywhere outside the ranges as defined in claim 5.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 25, 26, 28, 31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2002-275605.

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At least alloy no. 45 on page 8 of the JP '605 reference appears to be fully in accord with the compositions recited in the instant claims, and has a hardness within the range of instant claim 36.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 34, 39, 40, 42, 44, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-275605.

The JP '605 reference discloses alloy compositions that fully meet the compositional limitations required by the instant claims, as set forth in the rejection under 35 USC 102 supra. JP '605 does not disclose the properties as defined in the instant claims. However, because the actual compositions of the prior art and the instant claims may be identical, it is a reasonable assumption that the properties thereof would likewise be the same or nearly so; see *In re Best* (195 USPQ 430, CCPA 1977) or *In re Spada* (15 USPQ2d 1655, Fed.Cir. 1990). Thus, a prima facie case of obviousness is established between the disclosure of JP 2002-275605 and the presently claimed invention.

8. In a response filed June 25, 2008, Applicant has amended the claims such that none of the presently claimed compositions are disclosed or rendered obvious over the previously cited Shimizu et al. reference. However, a number of the instant claims remain rejected in view of the JP '605 reference, as indicated above. Because this

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rejection was not previously applied against claims 25 and 26, this action is non-final.

The prior art cited in the IDS filed June 25, 2008 has been fully considered.

9. Claims 1-3, 6, 8, 12-15, 17, 18, 20 and 24 are allowable over the prior art of record, and claims 27, 29, 30 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/George Wyszomierski/  
Primary Examiner  
Art Unit 1793

GPW  
October 6, 2008